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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant: Dovek et al. JAN 28 2004
Assignee: Maxtor Corporation OFFICE OF PETITIONS
Title: MAGNETIC STORAGE DEVICE WITH FLUX-GUIDED
MAGNETORESISTIVE HEAD USING A PERPENDICULAR
RECORDING MEDIA (AS AMENDED)
Serial No.: 09/067,795 Filed: April 28, 1998
Examiner: Letscher, G. Group Art Unit: 2652
Atty. Docket No.: 3123-276

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COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313

FEB 02 2004
Technology Center 2600

SECOND PETITION TO ENTER RESPONSE

Dear Sir:

This Petition is filed under 37 C.F.R. § 1.182 to request that the Response filed on April 1, 2003 be entered.

I. FACTS

The Decision on Appeal dated March 26, 2003 ruled on the non-final rejection of claims 1-60. The Decision (1) sustained the rejection of 1-4, 6, 7, 11, 13-15, 17-19, 21, 24-27, 29-34, 37, 42-48, 50, 53, 57, 58 and 60 based on *Tanaka et al.* (U.S. Patent No. 5,486,967) and reversed the rejection of claims 10, 49 and 55 based on *Tanaka et al.*; (2) reversed the rejection of claims 1-60 based on *Hesterman et al.* (U.S. Patent No. 5,434,733) in view of *Hamilton* (U.S. Patent No. 4,423,450); and (3) reversed the rejection of claim 55 based on *Somers* (U.S. Patent No. 5,097,371) in view of *Hamilton*.

Thus, the outstanding rejections for claims 5, 8, 10, 12, 16, 20, 22, 28, 35, 36, 38, 39, 40, 41, 49, 51, 52, 54, 55, 56 and 59 were reversed.

In the Response filed on April 1, 2003, claims 1, 17 and 30 were amended, claims 5, 20 and 36 were cancelled, and claims 61-83 were added. The Response explained these amendments and new claims as follows:

Claim 1 has been amended to rewrite claim 5 in independent form including all the limitations of the base claim and any intervening claim.

Claim 17 has been amended to rewrite claim 20 in independent form including all the limitations of the base claim and any intervening claim.

Claim 30 has been amended to rewrite claim 36 in independent form including all limitations of the base claim and any intervening claims.

Claim 61 constitutes claim 8 rewritten in independent form including all limitations of the base claim and any intervening claims. Claim 62 depends from claim 61 and corresponds to claim 9.

Claim 63 constitutes claim 10 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 64 constitutes claim 12 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 65 constitutes claim 16 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 66 constitutes claim 22 rewritten in independent form including all limitations of the base claim and any intervening claims. Claims 67-70 depend from claim 66 and correspond to claims 23-26, respectively.

Claim 71 constitutes claim 28 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 72 constitutes claim 35 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 73 constitutes claim 38 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 74 constitutes claim 39 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 75 constitutes claim 40 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 76 constitutes claim 41 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 77 constitutes claim 49 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 78 constitutes claim 51 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 79 constitutes claim 52 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 80 constitutes claim 54 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 81 constitutes claim 55 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 82 constitutes claim 56 rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 83 constitutes claim 59 rewritten in independent form including all limitations of the base claim and any intervening claims.

The Advisory Action dated August 14, 2003, refused to enter the Response as an improper amendment to a final rejection as follows:

The amendment filed 4/7/03 after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and Applicant's proposed new claim(s) present additional claims without canceling a corresponding number of finally rejected claims (37 CFR 1.116(c)). See also 37 CFR 1.198.. (Emphasis added.)

The Petition to Enter Response filed on August 18, 2003, requested that the Response filed on April 1, 2003 be entered. The Petition argued as follows:

The Examiner deems the captioned-application under final rejection. This is clearly erroneous. As the Decision makes clear, the claims are under non-final rejection. For this reason alone, the refusal to enter the Response is improper.

37 C.F.R. § 1.116(c) states as follows:

If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not presented earlier.

37 C.F.R. § 1.198 states as follows:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Neither Rule indicates that presenting new claims requires canceling a corresponding number of finally rejected claims. Moreover, the claims are not finally rejected.

37 C.F.R. § 1.196(c) states as follows:

Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement which shall be binding on the examiner in the absence of new references or grounds or rejection.

The Response dated April 1, 2003 complies with this Rule. Namely, the claims have been amended in conformity with the Decision. Accordingly, the Response should be entered.

The Decision on Petition dated January 14, 2004, denied the Petition. The Decision referenced M.P.E.P. § 1214.06 and stated as follows:

Had Applicant's response merely added claims 61-83 as indicated above, then entry of the response would have been acceptable. However, Applicant's attempt to incorporate claims 5, 20 and 36 into claims 1, 17 and 30, respectively, altered the scope of the remaining dependent claims. For example, prior to the Board of Patent Appeals and Interferences decision, claim 2 would have only required the particulars of claim 1 and the limitations set forth in claim 2 itself. With Applicant's proposed response, claim 2 would now require the particulars of claim 1, claim 5 as well as limitations set forth in claim 2. Therefore, Applicant has attempted to amend the claims which would require further prosecution.

II. ARGUMENT

The Director apparently recognizes that Applicant's attempt to incorporate claims 5, 20 and 36 into claims 1, 17 and 30, respectively, would have been acceptable for the same reason that new claims 61 through 83 were acceptable, had the dependent claims that depend from claims 1, 17 and 30 been cancelled.

Applicant agrees that the scope of the dependent claims that depend from claims 1, 17 and 30 would be altered by Applicant's proposed amendment to claims 1, 17 and 30.

Applicant also agrees that M.P.E.P. § 1214.06, cited by the Director, provides guidelines on the processing of an application after the Board of Patent Appeals and Interferences renders a decision, affirming the examiner in part.

Applicant submits that M.P.E.P. § 1214.07, not cited by the Director, also provides guidelines on the processing of an application after the Board of Patent Appeals and Interferences renders a decision, affirming the examiner in part. M.P.E.P. § 1214.07 states as follows:

If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be admitted, and with the concurrence of the supervisory patent examiner, the amendment will be entered. (Emphasis added.)

Form Paragraph 12.19 and the accompanying Examiner Note are as follows:

¶ 12.19 *Amendment After Board Decision, Entry Refused*

The amendment filed [1] after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and the proposed claim(s) raise new issues which require further consideration or search (37 CFR 1.116(c)). See also 37 CFR 1.198.

[2]

Examiner Note:

1. In bracket 2, identify the new issues.
2. This form paragraph is not to be used where a 37 CFR 1.196(b) rejection has been made by the Board of Patent Appeals and Interferences.

Applicant submits that the Response filed on April 1, 2003, obviously and unquestionably places the captioned-application in condition for allowance. Claims 1, 17 and 30 as amended are clearly acceptable. Although the dependent claims that depend from claims 1, 17 and 30 have altered scope due to the amendments to claims 1, 17 and 30, given that claims 1, 17 and 30 are in

condition for allowance, the dependent claims that depend from claims 1, 17 and 30 are also in condition for allowance.

Applicant further submits that since claims 1, 17 and 30 are allowable, the dependent claims that depend from claims 1, 17 and 30 do not raise new issues that would require further consideration or search.

Applicant further submits that it would be clearly erroneous to refuse entering the Response without the Examiner or the Director explaining what these new issues are.

Moreover, as mentioned above, the Advisory Action dated August 14, 2003, refused to enter the Response as an improper amendment to a final rejection as follows:

The amendment filed 4/7/03 after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and Applicant's proposed new claim(s) present additional claims without canceling a corresponding number of finally rejected claims (37 CFR 1.116(c)). See also 37 CFR 1.198.. (Emphasis added.)

In other words, the Examiner has not even alleged that the Response raises new issues that require further consideration or search. Instead, the Examiner merely observes that the Response presents new claims without canceling a corresponding number of finally rejected claims. This observation lacks any basis for refusing to enter the Response. The claims are not finally rejected, and the Examiner has not even attempted to explain how or why the Response raises new issues that require further consideration or search.

Applicant submits that the Rules do not specifically provide for the disposition of the Response in this situation. Furthermore, M.P.E.P. § 1214.06 should not be read in isolation from M.P.E.P. § 1214.07. Under M.P.E.P. § 1214.07, it is improper to refuse entering the Response merely because the scope of the dependent claims that depend from claims 1, 17 and 30 is altered. Instead, M.P.E.P. § 1214.07 entitles the Response to consideration as to whether it obviously places the application in condition for allowance, depending on whether the Response

raises new issues which require further consideration or search. In other words, M.P.E.P. § 1214.07 entitles the Response to similar consideration as an after-final amendment.

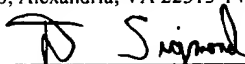
In this instance, the Response was carefully crafted to avoid raising new issues that require further consideration or search. The Response merely presents independent claims that were sustained on appeal, and retains previously existing dependent claims to depend from these independent claims. Applicant believes this is precisely what M.P.E.P. § 1214.07 contemplates, and the additional constraint that any alteration of claim scope is unacceptable, regardless of whether the Response obviously places the case in condition for allowance, regardless of whether new issues are raised that require further consideration or search, and regardless of whether these elements are discussed or ignored, is improper. Moreover, neither the Examiner nor the Director has not even attempted to explain why M.P.E.P. § 1214.07 is inapplicable or the Response fails to meet its criteria.

Applicant wishes to convey that this Second Petition is not an attempt to rehash the same issues presented to the Director on the initial Petition, and hopes this Second Petition is received in that spirit. Instead, since the Director sustained the Examiner for completely different reasons than set forth by the Examiner, and Applicant disagrees with the Director's position, Applicant believes it is appropriate to address the Director's position and request reconsideration.

Finally, to the extent there is basis for this Second Petition to be considered by (1) the Office of the Deputy Commissioner for Patent Examination Policy under M.P.E.P. § 1002.02(b), Section 11 (Petitions under 37 CFR 1.182), or (2) the Director under M.P.E.P. § 1002.02(c), Section 1 (Petitions or requests to reopen prosecution of patent applications after decision by the Board of Patent Appeals and Interferences), Applicant requests consideration by ODC rather than the Director.

Please charge any fee due under this Petition to Deposit Account No. 13-0016/276.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 20, 2004.



David M. Sigmond
Attorney for Applicant

1 / 20 / 04

Date of Signature

Respectfully submitted,



David M. Sigmond
Attorney for Applicant
Reg. No. 34,013
(303) 702-4132
(303) 678-3111 (fax)